



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
04/711,017	03/12/85	HAMASHIMA	Y 254/F4880-1W

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EXAMINER	
BENSON, R	
ART UNIT	PAPER NUMBER
122	2

DATE MAILED: 07/12/85

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

*for restriction only*

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ (month), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |  |   |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.       | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-498.                  |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449             | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/>   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-28 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☐ Claims \_\_\_\_\_ are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☒ Claims 1-28 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner, ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved, ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_, filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

Serial No. 711017  
Art Unit 122

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 11, 12 and parts of claims 1-10, 17 and 18, drawn to the cephem compounds, composition and method of use, classified in Class 514, subclasses 200, 201 and 202 and class 544, subclasses 16 and 22.

$X = 5$   
 $X = 50$   
where p is in?

II. Claims 1-10, 17 and 18 (part of each), drawn to the 1-oxo-cephem compounds, compositions and method of use, classified in Class 514, subclass 210 and class 544, subclass 105.

$X = 0$

III. Claims 13-16, drawn to the processes of making the compounds of inventions I and II, classified in Class 544, subclasses 16, 22 and 105.

IV. Claims 19-25, drawn to the intermediates, classified in Class 560, subclass 181 and class 548, subclass 194 and various other classes.

V. Claims 26, 27 and 28, drawn to the processes of making the intermediates of invention IV, classified in Class 560, subclass 181, class 548, subclass 194 and various other classes.

The inventions are distinct, each from the other, because of the following reasons:

Inventions I and II are not art recognized equivalents, the evidence of this are the completely different searches according to the PTO and International Classification systems and in the Chemical literature. The "nucleus" of these heterocyclic compounds is different for the two inventions and only the carboxyalkenyl "tail" at the 7 position is constant.

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Art Unit 122

Inventions IV and I+II are related as species in an intermediate-final product relationship.

Distinctness is proven for claims in this relationship if the intermediate product is useful other than to make the final product (MPEP 806.04(b), 3rd paragraph), and the species are patentably distinct. (MPEP 806.04(h)).

In the instant case, the intermediate product is deemed to be useful as the intermediates could be used to make polymers or to make penicillin compounds and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

Inventions III and I+II are related as process of making and product made.

The inventions are distinct if either (1) the process as claimed can be used to make another and materially different product, or (2) the product as claimed can be made by another and materially different process. MPEP 806.05(f).

In this case, the applicant has shown that there are several different ways of making the compounds of inventions I and II.

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Art Unit 122

Inventions V and IV are related as process of making and product made.

The inventions are distinct if either (1) the process as claimed can be used to make another and materially different product, or (2) the product as claimed can be made by another and materially different process. MPEP 806.05(f).

In this case, the applicant has shown that there are several different ways of making the compounds of invention IV.


Because these inventions are distinct for the reasons given above and the searches required for inventions I, II, III, IV and V are all different and since to examine all five inventions as one would place a considerable burden on the PTO restriction for examination purposes as indicated is proper.

In the event invention III or V is chosen a tentative election of one process is required.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed.

A telephone call to applicant's representative on or about June 10, 1985 did not result in election.

RB  
Benson:tgh  
A/C 703  
557-3920  
7-9-85

  
Donald G. Daus  
Supervisory Patent Examiner  
Art Unit 122